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******************AFTER FINAL*********FAX RESPONSE**

to the urgent attention of *Examiner Nasser Ahmad*

DCS-TWOSIDEDSTICKEYS

Applicant	**: David C. Schwartz**
Serial no	**: 09/735,375**
Filed	**: 12/12/2000**
For	**: TWO SIDED STICKYS**
Group art unit	**: 3722**
Examiner	**: Nasser Ahmad**

17 pp

Hon. Commissioner of Patents and Trademarks
Washington, D.C. 20231

Southboro, MA 07/06/2004

RESPONSE AFTER FINAL

This filing is an after final response and is based on the telephone interview which is summarized below and a copy of the Examiners summary notes of the interview is referenced herein. The response is filed prior to the three month response period of the last office action which was a rejection that was made final. No payment is required. Applicant has faxed his response using the number 703-872-9306. Examiner has indicated to the Applicant that he is departing on Friday, July 13th and returning on July 20th and that a fax response sent immediately upon receipt of the telephone summary would be given priority review to determine if an allowance after final can be granted for the amended claims contained herein prior to the Examiner's departure, since the action is within the three month period whose clock started on April 20, 2004. Therefore any favorable action would be sought prior to July 20, 2004.

Summary of Examiner's Telephone Action:

A copy of paper 16 which is the Examiner's summary of the telephone conference is attached herewith. Applicant includes a complete summary of the telephone conference in the Applicant's response below referencing the summary provided by mail by the Examiner.

Applicant's response:

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Applicant began the interview noting that the Examiner had maintained the rejection of claim 1 under 35 USC 102(b) as being anticipated by Marchese in the action of July 30,2003 and claims 1-3 under the rejection 35 USC 103(a) as being unpatentable over Marchese and requesting that the Examiner listen to the traversal with specific line references. Applicant first presented the agreement with the Examiner's citing that the Applicant's use of the term "at least three" in his claims warranted the arguments made by the Examiner using Marchese, but Applicant still did not agree with the Examiner's arguments as they applied to the Applicants claims. However, as a premise for the interview, Applicant agreed to accept the limitation and limit the scope of his claim to "solely three panels". Applicant proceeded to traverse the rejections in more persuasive detail with arguments as to why the applicants invention, with claims as proposed to be amended was not anticipated by Marchese nor obvious with respect to Marchese.

Applicant walked the Examiner through the Marchese patent column by column and line by line in the following sequence. The purpose was to not only clearly articulate the specific direction Marchese teaches but also to identify the structural relationship of the elements in Marchese that conform to his teaching, with the express intent of getting the Examiner to confirm the traversal of his rejection.

The interview proceeded as follows: In column #1 line 17, applicant pointed out that Marchese teaches that his adhesive strips are applied straight, and never folded into a loop. In column 1 line 35, Applicant pointed out that Marchese further teaches that his portions of selected length are separated and removed for application in selected quantities and in selected amounts to the sole of a shoe and never maintained as a continuous set of panels. Applicant then pointed out that Marchese teaches in column 1 line 52 that the tape portions are formed to be of optimum length and are for separation and removal. Then in column 2 line 10 and 14, Applicant pointed out that Marchese shows the optimum lengths in the figure 4 and Fig 6 which in fact is a ratio of long length to short length of 2.5:1 which is the length of a typical sole to a typical heel as also measured on countless shoes and recounted to the examiner. Applicant pointed out that this structure is dictated as optimum by the language of Marchese in column 3 lines 5-15 where he details the intended use of the short and long portions in his strip.

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This is reiterated in Column 3 lines 28-41 where the specific application of a long portion is to the sole and the short portion to the heel, confirming the ratio of the lengths of each panel with respect to the other. Applicant further pointed out that in the claim which is the specification column 4 lines 30-50 Marchese calls out the formation of pairs of short and long panels for removal in said lengths respectively. Then Applicant further pointed out the strip lamination as stated by Marchese in column 4 line 10, where there are five substrates being -grit/adhesive/material/adhesive/cover strip.

Upon this sequence, Applicant asked Examiner if in the claim as proposed to be amended that based on this disclosure, was not in fact the Applicant's claimed invention novel with respect to Marchese, and the Examiner confirmed with a yes that this was so.

With this point agreed, Applicant then restated the optimum lengths of Marchese as a length of 2.5 and a length of 1 and suggested that based on the teachings of Marchese, first it would not be obvious to select any 3 panels and pointed out that even if one were to select three panels, that the lengths, shown, taught, and specified as optimum would prevent the two short panels from folding over and onto one another to form a closed loop as is the invention of Applicant. Applicant then restated that there was no suggestion to select anything but two panels at a time and separate them, and certainly nothing prevented the selection of any three panels as pointed out by the examiner, but in no case would any selection of any group of three panels actually perform as a continuous loop of panels formable into a sticky loop. Applicant sought agreement from the Examiner that this argument was substinative enough to permit an allowance of the claim as amended stating that did Examiner not agree that it would not be obvious to take three panels when two are taught, and then take the panels and further change their lengths from the optimum lengths taught to make Marchese "work" as applicant's invention works, and then further not tear them apart but rather fold them in a loop rather than use them straight. Applicant said that three levels of inference would make Applicants invention unobvious with respect to this art. Applicant pointed out that in 100 percent of the tests made with the Applicants invention with no printed instructions was it obvious to the user what to do with Applicants invention even when boldly handed the device-and that imprinted instructions were required and even then the user had some problems forming the loop until one successful loop

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was made and experienced and then it was like walking or chewing gum. Applicant suggested that if it was not obvious to the user how to use Applicants invention that was of significance and that these same users, once experienced were delighted with the outcome and surprised. Applicant again reiterated that deriving Applicants invention from Marchese was not obvious to one skilled in the art for all the reasons presented.

The Examiner did not traverse the Applicant's arguments that the applicants invention was not obvious and took the position that the claim might now be reconsidered if the scope did not require another search. Further , in the opinion of the Examiner, the Examiner indicated that he could make a reexamination and if necessary a search and still rule on the proposed after final amendment in the time frame provided, which meant faxing urgently to his desk and calling him upon the sending of the Fax to confirm it was received. Applicant agreed to make immediate submission and Examiner indicated he would first summarize the interview. Since Examiner did not fax his summary to the Applicant, Applicant received the summary on July 6th by regular mail and required this summary from the examiner to proceed with his final proposed amendment and further understood this to mean that if the Applicant then faxed back his amended claims with the arguments after receipt of the telephone summary from the Examiner, which submission would be in support of the interview as documented by the Examiner the after final could be reviewed prior to his departure and a ruling made.

And most importantly with respect to changing scope and the need for a further search::::::

Applicant then pointed out that since the Applicant was limiting the scope of his claims with the amendment, and that since the prior search made by the Examiner was for a broader scope, that the prior art of record would be sufficient to reexamine without another search, I.e. That the search of record would have uncovered art within the scope of the amended claims and should therefore be sufficient to permit a review of the amended claims after final without an additional search and that based on the merits of the arguments and the amendment, permit an allowance for the revised claims. Applicant asked the Examiner that inspite of the above point, if he still chose to make a further search would there be time to complete that prior to his departure and he indicated that he saw no reason why he would not be able to

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do so.

The Examiner indicated that he thought that the Applicant might further specify his claim using the language label and made reference to the fact that this is a paper label. Applicant pointed out that labels are for marking generally and that Applicant did not teach marking, therefore the word label would not be appropriate however the word "tab sticker" might be applicable or some other similar word. Applicant respectfully declined to call it a label and specifically stated that calling out any language that unnecessarily limited his claims would not be in his interest and that he would have to consider this further and that he would and would use such or similar but suitable language in the proposed amended claims.

Applicant agreed to fax a formal amendment to the Examiner at his request as the Examiner did not offer to reach a final agreement on the proposed amended claims during the telephone interview for the reason that he might have to do another search and solely as the Applicant understood it, this was the only reason an agreement on an allowable claim was not reached on the phone. The Examiner listened to and recounted the proposed claim amendment and asked for that claim in final form and that the other claims be amended in a similar manner to limit their scope as agreed to. The Examiner indicated that the Applicant could call the Examiner to seek his confirmation of the receipt and timing for rendering what Applicant indicated he felt should be a constructive outcome, I.e. Permission of an allowance after final.

Applicant adds to the proposed final argument that the argument about the number of panels being limited to solely three and the prescribed relationship of the widths of each of the panels as detailed in claim 1, and the specific relationships in each of claim 2 and claim 3 all benefit from the traversal arguments against the anticipation and obviousness argument previously presented by the Examiner and are each allowable as now amended.

The Examiner indicated he would look at the claim in it's proposed final form and Applicant took this to mean that they would be able to converse again to reach a final and constructive outcome in the after final amendment as proposed .

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Proposed Action:
Applicant herewith respectfully requests that the Examiner acknowledge Applicants call to confirm receipt as agreed and that the Examiner consider that the Applicant has limited or narrowed the scope of his claims in all three claims, allowing for the use of the prior art search which was made covering claims of larger scope, and respectfully requests that the Examiner make due diligence effort with priority in the time left prior to his departure to reconsider the amended claims and the arguments which were presented and acknowledged during the telephone interview as being of merit to traverse the lack of novelty and the anticipation, and the obviousness rejections and arguments that had been prior offered by the Examiner and respectfully requests that the Examiner allow the claims as amended, act in this regard in this after final status with such allowance, allow the Applicant to call and confirm same, and permit this case to publish in due course as allowed.

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